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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,191	09/01/1999	MARK G. DREYER	27600/M195A	3487

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MCCRACKEN AND FRANK  
200 W. ADAMS STREET  
SUITE 2150  
CHICAGO, IL 60606

EXAMINER

PAULA, CESAR B

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 08/07/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/388,191

Applicant(s)

DREYER ET AL.

Examiner

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This action is responsive to the response filed on 6/5/2003.

**This action is made Final.**

2. Claims 1-26 are pending in the case. Claims 1, and 16 are independent claims.

#### *Drawings*

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### *Double Patenting*

4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) has been filed to overcome the obviousness-type double patenting rejection. Therefore the rejections of claims 1-26 have been withdrawn.

#### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-3, 5-8, 11-21, and 24-26 remain rejected under 35 U.S.C. 102(a) as being anticipated by Cohen et al, hereinafter Cohen (Pat.# 5,872,640, 2/16/99, filed 9/21/98).

Regarding independent claim 1, Cohen discloses generating a filled out template by combining a template—*first page description file*-- and a data file (c.3,L.1-67).

Moreover, Cohen discloses an application program, such as Framemaker, for generating a template (c.3,L.1-67).

Furthermore, Cohen discloses an application program for downloading/extraction of data into a file or database for generating a filled out the template—*second page description file* (c.3,L.1-c.4,L.67).

Regarding claim 2, which depends on claim 1, Cohen discloses generating a template with fields or placeholders for holding data from the data file (c.1,L.52-c.2,L.11, and c.3,L.1-67).

Regarding claim 3, which depends on claim 2, Cohen discloses an application program, such as Framemaker, for generating a template with fields or placeholders for holding data from the data file (c.1,L.52-c.2,L.11, and c.3,L.1-67).

Claim 5 is directed towards a software system for implementing the software found in claim 1, and therefore is similarly rejected.

Regarding claim 6, which depends on claim 1, Cohen discloses a database with a plurality of fields, and a user generating a template with fields or placeholders for *characterizing* data from the data file (c.1,L.52-c.2,L.11, and c.3,L.1-c.4,L.67).

Regarding claim 7, which depends on claim 1, Cohen discloses the parsing of a data file being made up of a keyword data portion, and a data portion—*first data portion, and a second data portion* for filling out the template (c.3,L.1-c.4,L.67).

Regarding claim 8, which depends on claim 7, Cohen discloses the inclusion of control data, such as the template to be parsed (c.3,L.1-c.4,L.67).

Regarding claim 11, which depends on claim 1, Cohen discloses the database which includes many templates (c.3,L.1-c.4,L.67).

Regarding claim 12, which depends on claim 1, Cohen discloses a data file for including the name—*image element* of a template to be filled out (c.3,L.37-c.4,L.67).

Furthermore, Cohen discloses the downloading and storage of data corresponding to the template to be filled out (c.3,L.1-c.4,L.67).

Regarding claim 13, which depends on claim 12, Cohen discloses program instructions for populating fields, and generating a filled out template (c.3,L.37-c.4,L.67).

Regarding claim 14, which depends on claim 1, Cohen teaches a computer program to allow a user to input or modify desired data into a data file for the purpose of filling out the template (c.4,L.12-c.5,L.61).

Claim 15 is directed towards a software system for implementing the software found in claim 14, and therefore is similarly rejected.

Claims 16-21, 24-26 are directed towards a method for implementing the system found in claims 1, 3, 5-8, 11-12, and 14 respectively, and therefore are similarly rejected.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 9, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen.

Regarding claim 4, which depends on claim 1, Cohen discloses generating a filled out template by combining a template—*first page description file*-- and a data file (c.3,L.1-67). Cohen fails to explicitly disclose: *page make-up software application comprises QuarkXPress*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included QuarkXPress, because Cohen teaches above the implementation of template generating software such as Adobe Framemaker.

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Regarding claim 9, which depends on claim 8, Cohen discloses a database with a plurality of fields being input by a user (c.1,L.52-c.2,L.11, and c.3,L.1-c.4,L.67). Cohen fails to explicitly disclose: *the user interface of the second routine*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included an user interface for inputting data into the database, because Cohen teaches above the customization data by a user(s).

Claim 22 is directed towards a method for implementing the system found in claim 1, and therefore is similarly rejected.

9. Claims 10, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen, in view of Mastie (Pat. # 6,480,866, 11/12/02, filed on 6/30/98).

Regarding claim 10, which depends on claim 1, Cohen discloses generating a filled out template by combining a template—*first page description file*-- and a data file (c.3,L.1-67). Cohen fails to explicitly disclose: *plurality of pages to be printed in a book*. However, Mastie teaches the printing of a plurality of pages in a book (c.4,L.14-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Cohen, and Mastie, because Mastie teaches above the creation of a book onto a single document which can be printed, stored, retrieved, etc.

Claim 23 is directed towards a method for implementing the system found in claim 10, and therefore is similarly rejected.

### ***Response to Arguments***

10. Applicant's arguments filed 6/5/2003 have been fully considered but they are not persuasive. Regarding claims 1-26, the Applicants submit that Cohen does teach or suggest extracting data from a first page description file to generate a database for storing the extracted data, and generating a second description file from the template (page 2, lines 19-27). The Examiner disagrees because, Cohen teaches the extraction, and downloading of data associated with the fields in a template/form file—*portions of the first description file*—, generating, storing the downloaded data in a database containing information for filling out a template and generating a second page description file (col.3, lines 37-col.4, line 67).

Moreover, the Applicants submit that Mastie does not disclose or suggest the extraction of data from a first page description file to generate a database, and employ the database in generating a second description file from the template (page 3, lines 3-12). As established above, Cohen teaches the generation of a database containing information required for filling out a template--second description file.

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### ***Conclusion***



11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Flannery (Pat. # 6,594,405), Kikinis (Pat. # 5,794,259), Flannery (Pat. # 6,594,405), Nishiyama et al (Pat. # 6,421,693), Gupta et al (Pat. # 6,199,079), Kikinis (Pat. # 5,794,259), Markus (Pat. # 6,499,042), and Light et al (Pat. # 6,192,380).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)


Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label "PROPOSED" or "DRAFT").

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).**

*CBP*

7/31/03

  
STEPHEN S. HONG  
PRIMARY L...